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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/965,163

Filing Date: September 27, 2001

Appellant(s): JOSHI, SHRIDHAR P.

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Sorinel Cimpoes  
Reg. No. 48,311  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 15, 2006 appealing from the Office action mailed

August 16, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2002/0093136	Moody	7-2002
5,851,148	Brune et al.	12-1998
2003/0036427	Brandstetter et al.	2-2003
2003/0100362	Horniak et al.	5-2003
2001/0039513	Erlichson et al.	11-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 14, 18, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody (US 2002/0093136) in view of Brune et al. (US 5,851,148) and Brandstetter et al. (US 2003/0036427).
3. Moody discloses the following;

A gaming machine receiving a wager to initiate play, randomly selecting an outcome for the game from a plurality of possible outcome, representing the selected

outcome on a visual display (20), awarding a monetary payout from the gaming machine for a winning outcome (paragraph 31), dispensing a tangible sweepstakes entry from the gaming machine in response to a predetermined outcome (paragraph 30), submitting the sweepstakes entry to enter the sweepstakes without involving the gaming machine, conducting the sweepstakes after the sweepstakes entry is dispensed from the gaming machine (paragraph 25 and summary), and the gaming machine in response to wagering on all available pay lines, in which the examiner interprets to be the max bet for one pay line as recited in claims 1, 14, 18, and 27.

Moody does not expressly disclose the following:

*A predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day and completing the tangible sweepstakes entry form manually with identifying indicia as recited in claims 1, 14, 18, and 27*

Brune et al teaches the following:

*A predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day as recited in claims 1, 14, 18, and 27. By having a plurality of different triggering events, one of ordinary skill in the art would provide game players with unexpected results like an increase in payout or other bonus type events.*

Brandstetter et al teaches the following:

Completing the tangible sweepstakes entry form manually with identifying indicia (paragraphs 19-21 and 37 and summary) as recited in claims 1, 14, 18, and 27. By completing a sweepstakes entry form manually, one of ordinary skill in the art

would provide game players a chance at a supplemental award to there initial gaming award.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Moody to include *a predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day* and the completion of the tangible sweepstakes entry form manually with identifying indicia as taught by Brune et al and Brandstetter to provide game players with unexpected results like an increase in payout or other bonus type events with a chance at a supplemental award to there initial gaming award.

4. Claims 3-4, 16, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody (US 2002/0093136) in view of Brandstetter et al. (US 2003/0036427) as applied to claims 1, 14, and 18 above, and further in view of Horniak et al. (Us 20030100362).

5. Moody in view of Brandstetter et al disclose the claimed invention as discussed above except for the following:

The selected outcome is a predetermined one or more of the plurality of possible outcomes, predetermined one or more of the plurality of possible outcomes being associated with the monetary payout exceeding a predetermined threshold and below a predetermined threshold as recited in claims 3-4, 16, and 20-21.

Horniak et al teaches the following:

One or more of the plurality of possible outcomes is associated with the monetary payout exceeding a predetermined threshold and below a predetermined threshold (paragraphs 43-44). By having a predetermined threshold associated with

the monetary payout, one of ordinary skill in the art would provide an incentive to the players of a slot machine to continue to use the slot machine (paragraph 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Moody to further include one or more of the plurality of possible outcomes being associated with the monetary payout exceeding a predetermined threshold and below a predetermined threshold as taught by Horniak to provide an incentive to the players of a slot machine to continue to use the slot machine.

6. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody (US 2002/0093136) in view of Brune et al. (US 5,851,148), Brandstetter et al. (US 2003/0036427) and Erlichson et al. (US 2001/0039513).

7. Moody discloses the following:

A gaming machine receiving a wager to initiate play, randomly selecting an outcome for the game from a plurality of possible outcome, representing the selected outcome on a visual display (20), awarding a monetary payout from the gaming machine for a winning outcome (paragraph 31), and dispensing a tangible sweepstakes entry from the gaming machine in response to predetermined outcome (paragraph 30), and conducting the sweepstakes after the sweepstakes entry is dispensed from the gaming machine (paragraphs 25, 53-58, and summary) as recited in claim 37.

Moody does not expressly disclose the following:

*A predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day and*

completing the sweepstakes entry from via a web site on an Internet with identifying indicia on an electronic sweepstakes entry form and submitting the electronic sweepstakes entry form via the website on the Internet to enter the sweepstakes without involving the gaming machine as recited in claim 37.

The website has a security access code for allowing access to the website as recited in claim 38.

Brune et al teaches the following:

*A predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day as recited in claims 1, 14, 18, and 27. By having a plurality of different triggering events, one of ordinary skill in the art would provide game players with unexpected results like an increase in payout or other bonus type events.*

Brandstetter et al teaches the following:

Completing the sweepstakes entry form with identifying indicia without involving the gaming machine (paragraphs 19-21 and 37-38 and summary) as recited in claim 37. By having completing the sweepstakes entry form, one of ordinary skill in the art would provide game players a chance at a supplemental award to there initial gaming award.

Erlichson et al teaches the following:

Submitting an electronic sweepstakes entry form via a website on the Internet (paragraph 5) and allowing access to the website (figures 1-4) as recited in claims 37 and 38. By submitting an electronic sweepstakes entry form via the

website on the Internet, one of ordinary skill would provide game players a chance at a supplemental award to there initial gaming award.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Moody to further include completing the sweepstakes entry from via a web site on an Internet with identifying indicia on an electronic sweepstakes entry form and submitting the electronic sweepstakes entry form via the website on the Internet to enter the sweepstakes without involving the gaming machine as taught by Brune et al, Brandstetter et al and Erlichson et al to provide game players with unexpected results like an increase in payout or other bonus type events with a chance at a supplemental award to there initial gaming award.

#### **(10) Response to Argument**

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine is found within the teachings of the combined references. Appellant contends that Brune fails to disclose a predetermined triggering condition, the triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day. The examiner respectfully disagrees. Brune teaches in col.

3, line 64 - col. 4, line 8, a wagering game where in order for the player to win a bonus a predetermined condition of a value of 5 must be met in order to activate predetermined outcome or the bonus. In order for the player to win the bonus the user must play a sufficient amount of games to achieve the bonus, which in this case is five. A trigger condition according to Brune is a threshold condition being met by different trigger events or items such as the number of game played, the number of non-winning games, the number of winning cards, and the like. By definition of a trigger condition in the art, is a threshold met by different predetermined conditions such as, a number of corresponding symbols, a number of non-corresponding symbols, the number of specialty symbols, the amount of money wagered during a period of time, the number of hours played etc. in order to activate any number bonus games, bonus awards, prizes, comps, free spins, etc. based on the threshold being met by the many different predetermined conditions. Giving a claim its broadest reasonable interpretation, Brune et al teach a wagering game where the limitation of a predetermined condition, said triggering condition being based on at least **one** of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day. Moody discloses a gaming machine where the player achieves a predetermined combination of playing cards or slot symbols on the gaming machine or on a random basis determined by the gaming machine that awards and dispenses a keno ticket, a lottery ticket, a sweepstakes ticket, an entry into a prize contest, a redeemable coupon or other valuable printed award in addition to any award that the player would have been entitled for achieving the combination of playing cards or slot symbols (paragraphs 0025 and 0026 of Moody). What Moody was lacking was the predetermined triggering condition and completing the sweepstakes entry form. The examiner notes that the claim limitation only requires at least one predetermined triggering condition. Brunet et al teaches a wagering game where at least **one** of the predetermined triggering conditions. As noted in

the office action above Brune et al is a wagering gaming machine cited to teach the predetermined triggering condition and Brandstetter is also a wagering gaming machine cited to teach completing a sweepstakes entry from which both are analogous to the art of gaming. By modifying Moody to include the teachings of Brune et al to include a plurality of different triggering events, one of ordinary skill in the art would provide game players with unexpected results like an increase in payout or other bonus type events. By further modifying Moody to include the teachings of completing the sweepstakes entry form, one of ordinary skill in the art would provide game players a chance at a supplemental award to there initial gaming award. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Moody to include a predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day and the completion of the tangible sweepstakes entry form manually with identifying indicia as taught by Brune et al and Brandstetter to provide game players with unexpected results like an increase in payout or other bonus type events with a chance at a supplemental award to there initial gaming award.

Appellant further contends that Brune also fails to disclose a tangible sweepstakes entry form. The examiner agrees with appellant that Brune et al does not disclose a tangible sweepstakes entry form. However, Brune et al was cited to teach the different trigger conditions as discussed above.

Appellant contends that Erlichson et al does not disclose a security access code for allowing access to the website.

Erlichson et al in figure 4 teaches the website having a security access code for allowing access to the website. Giving a claim it's broadest reasonable interpretation, the sweepstakes

manager (210) logging into the sweepstakes repository (200) over computer network, wherein the logging into the sweepstakes repository on the Internet is the security access code for allowing access to the website. The claim never recites who may access the website, but only that the website has a security access code for allowing access to the website. As noted above Brune et al is a wagering gaming machine cited to teach the predetermined triggering condition and Brandstetter is also a wagering gaming machine cited to teach completing a sweepstakes entry from which both are analogous to the art of gaming. Erlichson et al is an online sweepstakes system cited to teach electronic sweepstakes entry form via a website. By modifying Moody to include the teachings of Brune et al to include a plurality of different triggering events, one of ordinary skill in the art would provide game players with unexpected results like an increase in payout or other bonus type events. By further modifying Moody to include the teachings of completing the sweepstakes entry form, one of ordinary skill in the art would provide game players a chance at a supplemental award to there initial gaming award. By modifying Moody to further include the capability of electronic sweepstakes entry from via website, one of ordinary skill in the art would provide game players a chance at a supplemental award or added award to there initial gaming award. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Moody to include a predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player- tracking information, time of day and the completion of the tangible sweepstakes entry form manually with identifying indicia and submitting the electronic sweepstakes entry form via the website on the Internet to enter the sweepstakes without involving the gaming machine as taught by Brune et al, Brandstetter and Erlichson et al to provide game players with unexpected results like an increase in payout or other bonus type events with a chance at a supplemental award to there initial gaming award.

**(11) Related Proceeding(s) Appendix**

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Alex P. Rada



Conferees:

John Hotaling



Corbett Coburn

